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09/112,131	07/08/1998	JAY S. WALKER	96-002-C1	6549
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WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905			EXAMINER NGUYEN, CUONG H	
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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* JAY S. WALKER, BRUCE SCHNEIER, and JAMES A.
9 JORASCH
10

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12 Appeal 2008-0779
13 Application 09/112,131
14 Technology Center 3600
15

16
17 Decided: October 27, 2008
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20 Before WILLIAM F. PATE, III, LINDA E. HORNER, and
21 ANTON W. FETTING, *Administrative Patent Judges*.
22 FETTING, *Administrative Patent Judge*.

23 DECISION ON APPEAL

24 STATEMENT OF THE CASE

25 Jay S. Walker, Bruce Schneier, and James A. Jorasch (Appellants) seek
26 review under 35 U.S.C. § 134 of a non-final rejection of claims 177-189, the
27 only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
(2002).

We REVERSE.

The Appellants invented a way for an expert seeking to sell his services to more efficiently find a client, allow the client to certify and authenticate the expert's qualifications, allow the client to hire the expert under specific terms and conditions for a specific assignment, and have the service provider guarantee payment to the expert for the expert services to be provided while also guaranteeing the buyer's satisfaction with the expert service (Specification 13: Summary of Invention).

An understanding of the invention can be derived from a reading of exemplary claim 177, which is reproduced below [bracketed matter and some paragraphing added].

177. A computer implemented expert matching method for managing communications between an expert and an end user, comprising:

[1] receiving a first expert qualification corresponding to a first expert;

[2] selecting a second expert that has a second expert qualification,

the second expert qualification being higher than the first expert qualification;

[3] transmitting the first expert qualification to the second expert; and

[4] receiving a signal from the second expert

that indicates approval of the first expert qualification.

1 This appeal arises from the Examiner's non-final Rejection, mailed
2 August 25, 2005. The Appellants filed an Appeal Brief in support of the
3 appeal on November 20, 2006. An Examiner's Answer to the Appeal Brief
4 was mailed on February 7, 2007. A Reply Brief was filed on April 9, 2007.
5 Oral arguments were presented in a hearing on September 10, 2008.

6 PRIOR ART

7 The Examiner relies upon the following prior art:
8 US Patent and Trademark Office, Manual of Patent Examination Procedure,
9 Rev. 14, Nov. 1992 (MPEP)

10 REJECTIONS

11 Claim 177 stands rejected under 35 U.S.C. § 102(b) as anticipated by
12 MPEP.

13 Claims 178-189 stand rejected under 35 U.S.C. § 103(a) as unpatentable
14 over MPEP.

15 ISSUES

16 The issues pertinent to this appeal are

- 17 • Whether the Appellants have sustained their burden of showing that
18 the Examiner erred in rejecting claim 177 under 35 U.S.C. § 102(b) as
19 anticipated by MPEP.
- 20 • Whether the Appellants have sustained their burden of showing that
21 the Examiner erred in rejecting claims 178-189 under 35 U.S.C. §
22 103(a) as unpatentable over MPEP.

1 The pertinent issues turn on whether the MPEP describes the steps
2 recited in the claims.

3 FACTS PERTINENT TO THE ISSUES

4 The following enumerated Findings of Fact (FF) are believed to be
5 supported by a preponderance of the evidence.

6 *MPEP*

7 01. MPEP § 705.01(e) is directed toward limitations as to the use of
8 patentability reports.

9 02. MPEP § 706 is directed toward the analysis of rejections
10 against claims in patent applications.

11 03. MPEP § 1002.02 is directed toward delegation of authority to
12 decide petitions.

13 04. MPEP § 1005 is directed toward exceptions to partial-signatory
14 authority.

15 *Facts Related To The Level Of Skill In The Art*

16 05. Neither the Examiner nor the Appellants has addressed the level
17 of ordinary skill in the pertinent arts of consultant selection,
18 management, and hiring. We will therefore consider the cited prior
19 art as representative of the level of ordinary skill in the art. *See*
20 *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001)
21 (“[T]he absence of specific findings on the level of skill in the art
22 does not give rise to reversible error ‘where the prior art itself
23 reflects an appropriate level and a need for testimony is not

shown”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

06. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily)

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity,

deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. See also *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, at 1739.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

“For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.*

“Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 1742.

ANALYSIS

Claim 177 rejected under 35 U.S.C. § 102(b) as anticipated by MPEP.

The Examiner found that the MPEP anticipated claim 177 (Answer 4-6). The Appellants contend that that the prior art does not describe selecting a second expert that has a second expert qualification which is higher than the

1 first expert qualification of a first expert for which a first expert qualification
2 was received (App. Br. 20:¶ 3.3).

3 We agree with the Appellants. The Examiner finds this limitation in
4 MPEP § 705.01(e). The pertinent portion reads

5 Where it can be shown that a Patentability Report will
6 save total examiner time, one is permitted with the approval of
7 the group director of the group to which the application is
8 assigned. The "Approved" stamp should be impressed on the
9 memorandum requesting the Patentability Report.

10 MPEP 700-5: Right column. This portion describes having the group
11 director approve a patentability report (FF 01). It says nothing regarding
12 selecting a second expert that has a second expert qualification which is
13 higher than the first expert qualification of a first expert for which a first
14 expert qualification was received.

15 The Examiner also refers to pp. 705-5 to 700-8 for support without
16 indicating where such support is found in those pages (Answer 6). Aside
17 from section 705.01(e) discussed above, the remainder of these pages only
18 describe the manner of making a rejection (FF 02), and have no description
19 regarding communications among USPTO personnel or selecting experts.
20 The Examiner also finds support in MPEP § 1005, Exceptions to Partial-
21 Signatory Authority (Answer 5). This section is a list of types of actions
22 such an examiner lacks authority to sign (FF 04). This section also has no
23 description regarding communications among USPTO personnel or selecting
24 experts.

25 The Examiner makes findings as to the context within which these
26 sections arise, and describes a scenario in which the business practices

1 performed within that context would result in the steps in claim 177. The
2 Examiner provides no evidence to support those findings as to the context,
3 leaving the Examiner's scenario as no more than a speculative hypothetical
4 situation, rather than evidence of anticipation. More critically, the
5 Examiner's rejection is over the MPEP, not the business practices within
6 which the MPEP is used.

7 The Examiner has not shown that the MPEP describes the steps in claim
8 177. The Examiner has therefore failed to put a prima facie case for
9 anticipation forward. Accordingly, there is no need to reach the remaining
10 Appellants' arguments.

11 The Appellants have sustained their burden of showing that the
12 Examiner erred in rejecting claim 177 under 35 U.S.C. § 102(b) as
13 anticipated by MPEP.

14 *Claims 178-189 rejected under 35 U.S.C. § 103(a) as unpatentable over*
15 *MPEP.*

16 The Examiner found that the MPEP described the steps in claims 178-
17 189 and found that it would have been obvious to automate those steps
18 (Answer 4-6).

19 Independent claim 178 further requires incorporating expert identity data
20 into a key. We find that because claim 178 is computer implemented, the
21 key as claimed is a data file key, consistent with the Specification 38: First
22 full ¶. The Appellants contend that that the prior art does not describe such
23 incorporation into a computer data file key (App. Br. 42-44:¶ 4.3.1).

1 We agree with the Appellants. The Examiner found that MPEP
2 § 1002.02, Delegation of Authority to Decide Petitions, described putting
3 identity data into a key (Answer 7). This section describes how the authority
4 granted to the Commission is often delegated (FF 03), but does not describe
5 placing identity data of anyone into any kind of a computer data file key.
6 The Examiner apparently finds that the placing of a supervisor or director
7 name on a petitions decision puts identity data into a key. Again the
8 Examiner has not applied what is described in the MPEP but rather has set
9 forth a hypothetical situation in which identity data is written on a document.
10 Even if the MPEP did describe this, the Examiner has not shown the
11 document itself to be a computer data file key, or that it would have been
12 obvious, from such a practice of placing names on a decision, to incorporate
13 those names in such a key.

14 The Examiner has therefore failed to put a prima facie case for
15 nonpatentability forward. Accordingly, there is no need to reach the
16 remaining Appellants' arguments.

17 Independent claim 179 further requires submitting a first expert's
18 qualification to a set of experts and sending the first expert's answer to the
19 user. The Appellants contend that that the prior art does not describe such
20 submission to a set of experts (App. Br. 48-49:¶ 5.1.1.2).

21 We agree with the Appellants. The Examiner made no findings that any
22 of the claimed steps were described in the MPEP, other than those discussed
23 in relation to claim 178 *supra* (Answer 7). The Examiner apparently found
24 that submitting an examiner's resume to multiple supervisors to be such a
25 submission. Again the Examiner has not applied what is described in the

1 MPEP but rather has set forth a hypothetical situation in which supervisors
2 review examiner resumes. The Examiner provides no evidence to support
3 those findings, leaving the Examiner's scenario as no more than a
4 speculative hypothetical situation, rather than evidence of obviousness.
5 More critically, the Examiner's rejection is over the MPEP, not the USPTO
6 hiring practices, which are unrelated to the portions of the MPEP placed in
7 the record.

8 The Examiner has therefore failed to put a prima facie case for
9 nonpatentability forward. Accordingly, there is no need to reach the
10 remaining Appellants' arguments.

11 Independent claim 185 combines the limitations of claims 177 and 179.
12 The Appellants repeat their contentions from claim 177 (App. Br. 51-52:¶
13 5.2).

14 We agree with the Appellants. The Examiner made no findings that any
15 of the claimed steps were described in the MPEP (Answer 9). The Examiner
16 repeated the claim limitations with no findings as to where those limitations
17 are described in the MPEP. Again the Examiner has not applied what is
18 described in the MPEP, and has not even set forth a hypothetical situation as
19 done with other claims.

20 The Examiner has therefore failed to put a prima facie case for
21 nonpatentability forward. Accordingly, there is no need to reach the
22 remaining Appellants' arguments.

1 The Appellants have sustained their burden of showing that the
2 Examiner erred in rejecting claims 178-189 under 35 U.S.C. § 103(a) as
3 unpatentable over MPEP.

4 CONCLUSIONS OF LAW

5 The Appellants have sustained their burden of showing that the
6 Examiner erred in rejecting claim 177 under 35 U.S.C. § 102(b) as
7 anticipated by the MPEP and claims 178-189 under 35 U.S.C. § 103(a) as
8 unpatentable over the MPEP.

9 DECISION

10 To summarize, our decision is as follows:

- 11 • The rejection of claim 177 under 35 U.S.C. § 102(b) as anticipated by
12 MPEP is not sustained.
- 13 • The rejection of claims 178-189 under 35 U.S.C. § 103(a) as
14 unpatentable over MPEP is not sustained.

15
16 REVERSED

17
18
19 vsh

20
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